

REJECTIONS

Claims 120, 124 and 126 were rejected under 35 U.S.C. § 112, first paragraph (enablement).

Claims 119, 120, 122, 124-127 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly et al (5,816,918) in view of Huang (5605504).

Claims 121, 123 were rejected under 35 U.S.C. § 103(a) using Kelly (Fig. 5b) and by using Huang (highlighting).

REMARKS

Claims 119-127 are pending in this application. Of these, claims 119, 122, 125, and 127 are independent.

REJECTIONS UNDER 35 USC 112 PARAGRAPH 1 (ENABLEMENT)

Applicant respectfully traverses the rejection of claims 120, 124, and 126 under 35 U.S.C. § 112, first paragraph, for failing to enable a person skilled in the art to make the claimed invention. Section 2164.04 of the M.P.E.P. states:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.

In addition, Section 2164.01(b) of the M.P.E.P states (citations omitted):

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied ... Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112.

Each of claims 120, 124, and 126 recite an electronic gaming unit having a display unit comprising a touch sensitive video display screen and a user input device comprising part of the touch sensitive video display screen. Pages 5 and 6, along with Figs. 2A-2F, describe multiple embodiments of the claims and the application describes using the virtual object in combination with the touch screen at least on page 6:

"In addition, one skilled in the art will realize that the virtual object 12 may not need to be the sole and exclusive input device 26. Other input devices 26 such as touch screens, buttons, joysticks, trackballs and the like may be use[d] alone or in combination with the virtual object 12." Application Specification page 6.

Moreover, the notion that a touch screen can be used both as an input device and an output device should not be foreign to those skilled in the art, because a touch screen is inherently both an input and output device. Touch screens are well known for being able to display images while at the same time accepting input from a user. The specification indicates that the touch screen can be used as an input device and that the virtual object may be used as an input device. Thus, one skilled in the art would recognize that the virtual object can be, for example, a shape encompassing a portion of the touch screen. Touching portions of the touch screen corresponding to the shape of the virtual object may therefore provide input into the gaming unit to activate aspects of the system of the recited claims. Therefore, based on a reading of the specification, one skilled in the art would be more than enabled to construct the gaming unit of claims 120, 124, and 126.

REJECTIONS UNDER 35 USC 103(A)

Claims 119, 120, 122 and 124-128

Applicant respectfully traverses the rejection of claims 119, 120, 122, and 124-127 as obvious over Kelly et al. (U.S. Pat. No. 5,816,918) in view of Huang (U.S. Pat. No. 5,605,504).

[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)(italics original). In addition, all elements of the claim must be found in the proposed combination. Specifically, MPEP section 2143.03 states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the

patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Neither Huang nor Kelly discloses a controller being programmed to cause a portion of the images to be highlighted in response to a user pointing a virtual object at the portion of the images as claimed. Therefore, no combination of Huang and Kelly can render claims 119, 120, 122, and 124-127 obvious.

As acknowledged by the Examiner, Kelly does not disclose a controller being programmed to cause a portion of the images to be highlighted in response to the user pointing a virtual object at a portion of the images, and instead, the office action cites Huang for such a teaching. While Huang discloses highlighting an image, Huang does not disclose a virtual object, and therefore cannot disclose highlighting an image in response to pointing a virtual object. According to the citation provided by the Examiner (Col. 2, lines 59-63), Huang highlights an image, i.e., a number on a touch screen, only after a user has selected the image. Pointing an object at an image is not the same as selecting an image because both can be done independently and separately from each other. Even in an embodiment in which the virtual object is integrated with the touch screen, as discussed above, a separate entity, i.e., a virtual object, may be made to point at the said images without selecting them. The method of the pending claims, on the other hand, requires highlighting in response to pointing at, not necessarily selecting, an image.

Independent claims 119, 122, 125, and 127 are amended to more specifically recite a controller being programmed to cause the virtual object to provide feedback to the user through the virtual object when a selectable item is selected, wherein the feedback is based on a characteristic of the virtual object. While Kelly discloses the use of feedback mechanisms in gaming apparatuses, Kelly does not disclose providing feedback based on a characteristic of the virtual object. An aspect of the system of the pending claims may have the virtual object take on a characteristic of the object being portrayed. For example, the firing of a gun may cause the virtual object to provide a force simulating a kickback. This feedback therefore is provided to simulate a characteristic of an object which the virtual object is portraying. Kelly does not disclose this element. Furthermore, Kelly does not

disclose that the feedback is triggered when an item is selected. Kelly only discloses that it may be possible to incorporate an actuator, such as a motor, in providing feedback in a gaming apparatus. This is not the same as teaching feedback based on item selection or a characteristic of the virtual object as claimed.

Because Kelly and Huang fail to disclose a controller programmed to highlight images in response to pointing a virtual object at a portion of the images, and providing feedback through a vertical object based on a characteristic of the virtual object, no combination of Kelly and Huang can render claims 119, 120, 122, and 124-127 obvious.

Applicant further traverses the rejection of claim 127 as obvious over Kelly in view of Huang. Claim 127 recites a selection switch coupled to a virtual object and a controller programmed to display a virtual indicator when selecting a selectable item using the switch while the virtual object is pointing at the image, wherein the virtual indicator is based on a characteristic of the virtual object. In addition to the above mentioned deficiencies of Kelly and Huang, Kelly and Huang fail to disclose a selection switch or displaying a virtual indicator when selecting an item and pointing the virtual object at an image as claimed. In fact, the office action does not appear to address this element in the body of the office action. Therefore, the office action fails to make a prima facie case of obviousness under 35 U.S.C. § 103, at least in regards to claim 127.

Also, as amended, claim 127 now recites that the virtual indicator is based on a characteristic of the virtual object, which Kelly and Huang also fail to disclose.

Claims 121 and 123

Applicant respectfully traverses the rejection of claims 121 and 123 as being obvious in view of Kelly and obvious in view of Huang. Each of claims 121 and 123 recite a controller programmed to cause a set of cross-hairs to be displayed on one of the images in response to the user pointing the virtual object at a portion of the display device. The office action cites Figure 5b for disclosing a cross hair over an image because Figure 5b shows a crosshatched pattern on an icon. However, the cross-hatched icon shown in Figure 5b is not the same as providing a set of cross-hairs over an image as claimed. Instead, the crosshatched icon of Figure 5b is a byproduct of a stylistic drawing choice common in

drafting patent applications. In fact, the crosshatched icon shown in Figure 5b represents a way of demonstrating emphasis in patent application drawings and has nothing to do with a crosshair. The drafters of Kelly might just as easily used a shade of gray to highlight that aspect for discussion. Also, as discussed above, while Huang may indicate highlighting an image when a player selects the image, selection of an image and pointing at an image is not synonymous. At best, Huang discloses highlighting an image after selection of the image, while the pending claims recite highlighting an image in response to pointing a virtual object. Therefore, Kelly and Huang cannot render claims 121 and 123 obvious.

CONCLUSION

In conclusion, the applicant submits that all pending claims are novel and non-obvious and are in condition for allowance. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, the Examiner is respectfully invited to telephone the undersigned.

Dated: December 20, 2004

Respectfully submitted,

By WJ Kramer
William J. Kramer

Registration No.: 46,229
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant